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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,425

Applicant(s)

STAHL, BRONISLAW-JAN

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004 and 25 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-59 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 31, 33-42, 44-49, 51-53 and 55-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 32 and 43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7-11-03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Species B (natural flavors) in the reply filed on April 28, 2004, is acknowledged. "Applicants request the examiner to exercise his discretion and permit a shift to species A", because (1) the instant restriction requirement is the first restriction in the case, and hence Applicants had no reason to expect that the instant claims would be deemed to cover an unelected invention," and "(2) some of the subject matter of species A was covered by previously presented claim 16 (encapsulated natural vegetable flavors), which the Examiner must have searched and examined."

This is not found persuasive because applicant's amendment after the first Office action necessitated the restriction requirement. The Examiner provided a search of the originally claimed subject matter, and – to paraphrase applicant's comment – hence had no reason to expect that the instant claims would be amended to cover an non-elected invention. Applicant's original claim 1 (essentially) encompassed chewing gums with coatings of one of natural vegetable flavorings, acids, or high potency sweeteners. This was the subject matter searched. Applicant's currently-amended claim 31 (replacing claim 1) encompasses chewing gums with coatings comprising at least one flavor, wherein the at least one flavor is (a) an encapsulated flavor, (b) a natural vegetable flavoring agent, or (c) both (a) and (b) above. This is a completely different set of limitations from the originally-examined claims. Applicant requested the Examiner "to exercise his discretion"; however, it is believed that permitting the amended claim shift to flavors as the coating component limitation, from the original set of natural vegetable flavors, acids or high potency sweeteners, constitutes acceptable and reasonable leniency on the part of the Examiner, especially when the original claims equally read upon gums with coatings comprising acids or high potency sweeteners, with no flavorings whatsoever. Note that such acids and high potency sweeteners are now simply further active substances in certain dependent claims.

Claims 32 and 43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 28, 2004.

The requirement is still deemed proper and is therefore made FINAL.

Response to Amendment

In the first Office action, claims 23-27 were objected to under 37 CFR 1.75(c) as being in improper form. In the response of August 25, 2003, applicant contends that the PTO did not remedy applicants' error in amending the claims within the preliminary amendment of September 05, 2000. Applicant contends that they provided instructions for amending the claims, plus a general statement that, if any claims were missed "inadvertently", the PTO should amend the claims according to applicants' blanket statement also provided therein. In the current response, applicant also states that:

In consequence, the PTO should have amended "1-22". to read just "1", eliminating the multiple dependency of [claim] 23 and rendering [claims] 23-27 examinable. Hence, the failure to examine [claims] 23-27 on the merits was improper, and the next action cannot be made final.

This is not deemed persuasive. If applicant inadvertently neglected to amend certain claims which were already presented to the PTO in the originally-filed application, the PTO is not at liberty to attempt to discern which claims applicant truly intended to amend, and does not have the resources to provide this service to applicant. All amendments must be submitted clearly and specifically, providing the necessary changes to each claim individually. For the record, the following statements were made by the Examiner in the previous Office action:

- Note that applicants' preliminary amendment did not set forth the precise elements to be deleted, and thus the elements that were deleted -- as instructed -- in the claims, were "such as" (twice), "aloe vera", and "tomato". Again, applicants are strongly reminded of careful and specific amendment to the claims.
- Several of applicants' preliminary amendments do not correspond to the actual claims, thus leaving the claims both incomplete and grammatically incorrect. Careful review of each of the previously submitted amendments, as well as any subsequent amendments, is strongly suggested. For example, the preliminary amendments to claims 8 and 9 render the claims incomplete, as these phrases are not specifically found within the claims.

Thus, even applicants' own specifically-recited amendments rendered the claims indefinite and/or incomplete. It is unclear, then, how the PTO could be expected and able to correctly ascertain which claim amendments applicant did, or did not, intend to make. Whether inadvertent or otherwise, it was applicants' representative who failed to amend the claims as desired. A general blanketing statement requesting the PTO to search, locate and determine any potential amendments "inadvertently" missed by applicant, is not proper or practical. It is not the charge of the PTO to do so, and is not within the power and ability to efficiently serve the applicant.

This rejection is made FINAL.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 51 recites the limitation "the encapsulated active substance" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is believed that this claim should be dependent upon claim 49.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

i) Claims 31, 33-42, 44-49, 52, 53 and 55-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Cherukuri et al. (US PAT 4,250,195, of record in IDS). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed August 25, 2003, have been fully considered but they are not persuasive. At page 9 of the response, applicant states that

Cherukuri et al. does not disclose the use of encapsulated flavors and/or natural vegetable flavoring agents in the form of a powder as claimed in new claim 31. It should be noted that contrary to Cherukuri et al. the present invention does not require sucrose powder to be added together with the flavor powder.

This is not deemed persuasive for the reasons of record. Applicant's statement that "Cherukuri et al. does not disclose the use of... natural vegetable flavoring agents in the form of a powder", is incorrect, and in fact, contrary to applicant's own statement made preceding this passage at page 9 of the response of August 25, 2003, which demonstrate that a spray-dried flavor may be added to a dusting mix which is applied to the coating of the gum.

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Again, Cherukuri et al. disclose a method for producing a coated chewing gum, wherein the chewing gum is coated with a series of syrups, as well as flavorings, sweeteners, bulking agents, etc. Column 4 of the reference discloses the application of flavorings, either in natural form, synthetic form, or as spray-dried flavorings. Spray-dried flavorings are either added with the dusting mix after an application of the syrup coating, or after the syrup and dusting mix is applied. The coating flavorings are present in amounts of about 0.5 to 5% of the coating, and “comprise oils derived from plants, leaves, flowers, fruit, etc.” Such flavors include various citrus flavors, peppermint, spearmint, apple, cherry, strawberry, etc. As spray-dried flavors are in powdered form, these meet the limitations of the instant claims. Furthermore, as stated at column 3, “the dusting mix comprises a dry powder mixture containing one or more sweeteners (or bulking agents).” The coating syrup utilized is an aqueous solution of the sweetener or bulking agent, and optionally a film-forming agent (see col. 2). The number of applications of the coatings may vary, to be “repeated as many times as necessary to build up a desired coating weight and thickness to smooth out the coating and provide the desired shine thereto” (col. 2).

Examples of sugar sweeteners or bulking agents suitable for use in the first coating syrup may comprise substantially any known sugar sweetener, such as arabinose, xylose, ribose, glucose, mannose, galactose, fructose, or sorbose, beet sugar or sucrose, lactose, maltose or cellobiose as well as corn syrup solids, and combinations thereof, with sucrose being preferred. [col. 2]

Where employed, the synthetic sweeteners may be present in the chewing gum center in an amount within the range of from about 0.04 to about 2% and preferably from about 0.4 to about 0.8% by weight of the chewing gum. Examples of synthetic sweeteners suitable for use herein include free saccharin acid, sodium, calcium or ammonium saccharin, cyclamate salts, dihydrochalcones, glycyrrhizic acid and salts, L-aspartyl-L-phenylalanine methyl ester and mixtures thereof. [col. 4]

Note that the inherent nature of powders would place these compositions within the limitations of instant claims 33-34 and 38-39, absent any clear and convincing evidence and/or arguments to the contrary. Further, the addition of synthetic sweeteners and their salts, is disclosed at column 4, thus reading upon instant claim 53.

It is noted that powdered flavoring agents, whether prepared by spray-drying or freeze-drying or some other method, would not be considered patentably distinct from one another, simply due to the method of their production. Thus the disclosed powder composition anticipates the claims.

It is noted that, similar to original claims 2-15, new claims 46-47 are not necessarily direct positive limitations of claim 44. These claims only further limit claim 44 by requiring that, *if* selected, the limitations in claims 46-47 would be met. As choices other than the acid or high potency sweetener exist in claim 44, the limitations of claims 46-47 need not be met.

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****** Note that, regarding instant claim 40, it is unclear as to how seeds, which are to be “substantially intact”, may be part of a flavoring agent “in the form of a powder”, as required by claim 31.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**KEITH HENDRICKS
PRIMARY EXAMINER**